

PATENT
App. Ser. No.: 10/600,382
Atty. Dkt. No. ROC920030127US1
PS Ref. No.: IBMK30127

REMARKS

This is intended as a full and complete response to the Final Office Action dated September 8, 2006, having a shortened statutory period for response set to expire on December 8, 2006. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1, 3-27 are pending in the application. Claims 20 has been amended. Applicants submit that the amendments do not introduce new matter.

Claim Objections

Claim 20 has been objected to for reciting "for storing" and "for mapping" in the claim. Claim 20 has been amended to instead refer to "to store" and "to map," as suggested by the Examiner. Accordingly, Applicants request withdrawal of this objection.

Claim Rejections - 35 U.S.C. § 101

Claim 20 is rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claim 20 has been amended as suggested by the Examiner. Accordingly, Applicants request withdrawal of this objection

Claim Rejections - 35 U.S.C. § 103

Claims 1, 3-4, 10 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Vogel* (US Patent 6,665,681) in view of *Sommerer et al.* (US 2004/0205514 A1, hereinafter "*Sommerer*"). Applicants respectfully traverse this rejection.

PATENT
App. Ser. No.: 10/600,382
Atty. Dkt. No. ROC920030127US1
PS Ref. No.: IBMK30127

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143.

The present rejection fails to establish at least the third criterion. For example, the references, even if combined as suggested in the Office Action, fail to teach *creating indexes to an annotated data object based on one or more identifying parameters that identify a location of the annotated data object*, as recited in independent claims 1, 10, and 15.

First off, while the Examiner refers to column 4, lines 13-16 as teaching creating an annotation, Applicants respectfully submit that *Vogel* makes no mention anywhere of annotations at all. In fact, Applicants fail to find any teaching in *Vogel* that might even reasonably be construed as referring to annotations. It appears that perhaps the Examiner ignored to term annotation in the claim and made no attempt to indicate any corresponding teaching of annotations in *Vogel*.

Further, while the Examiner refers to column 2, lines 14-17 as teaching creating an index to an annotated data object, Applicants respectfully submit that the cited portion not only does not teach creating an index at all, but, as previously described, *Vogel* makes no mention of annotations at all. The only mention of indexes at all in *Vogel* are with reference to a *topical index containing one or more broad classifications of topics*. There is no teaching, however, of creating this topical index at all, much less creating this topical index *based on parameters identifying a location of an annotated data object*, as recited in the claims.

PATENT
App. Ser. No.: 10/600,382
Atty. Dkt. No. ROC920030127US1
PS Ref. No.: IBMK30127

The Examiner relies on *Sommerer* as teaching a record containing a reference and an index, referring to paragraph 0049. Applicants respectfully submit, however, that there is no teaching in *Sommerer*, at all, of *creating indexes to an annotated data object based on one or more identifying parameters*, as recited in the claims. The only reference to an index at all is to state that information may be stored in a "searchable index." However, there is certainly no teaching of creating this searchable index *based on parameters identifying a location of an annotated data object*, as recited in the claims.

Because the present rejection fails (by a great margin) to satisfy the third criterion of establishing an obviousness rejection, Applicants respectfully submit independent claims 1, 10, and 15, as well as their dependents, are allowable. Accordingly, Applicants request withdrawal of this rejection.

Claim Rejections - 35 U.S.C. § 102

Claims 20-27 are rejected under 35 U.S.C. 102(e) as being anticipated by *Bays* et al. (US Patent 6,519,603 B1). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Bays* does not disclose "each and every element as set forth in the claim." For example, *Bays* does not disclose the claim 20 limitation of "a plurality of mappings, each containing functions for mapping a set of identifying parameters for a different type of data object to one or more columns in the index table."

PATENT
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Atty. Dkt. No. ROC920030127US1
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The Examiner argues that *Bays* discloses "mappings" at column 2, lines 61-63. However, the cited section simply discusses different attributes an annotation structure may contain. (*Bays*, Column: 2, Lines: 61-63). Nothing is mentioned in the cited section, nor anywhere else in *Bays* regarding "mappings...containing functions for mapping a set of identifying parameters for a different type of data objects to one or more columns in the index table."

In responding to Applicants' previously presented arguments to this effect, the Examiner states that:

Bays reference shows that attributes have a constraint on their data type that is to be consistent with input list. Therefore the annotated structure may change with those constraints resulting in multiple structures that could be understood as mappings

Applicants would like to point out that the claimed mappings each contain "functions for mapping to map a set of identifying parameters for a different type of data object to one or more columns in the index table." However, there is no mention of an index table at all in *Bays*. Therefore, Applicants respectfully submit that the teaching in *Bays*, of placing constraints on data types of attributes, *could not be understood* as mappings that each contain "functions for mapping to map a set of identifying parameters for a different type of data object to one or more columns in the index table" as recited in the claims.

Therefore, Applicantssubmit claim 20 and its dependents are allowable, and respectfully request withdrawal of this rejection.

PATENT
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Conclusion

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

The Examiner is strongly encouraged to contact Gero McClellan, attorney of record, at (336) 643-3065, to discuss strategies for moving prosecution forward toward allowance, otherwise (if the current rejections are maintained) an appeal appears imminent.

Respectfully submitted, and
S-signed pursuant to 37 CFR 1.4,

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